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# Supreme Court of the United States

J.E.M. AG SUPPLY, INC.
(doing business as Farm Advantage, Inc.),
FARM ADVANTAGE, INC., LARRY BENZ, MERLE PRUETT
(doing business as Siouxland Seeds, Inc.),
KEVIN WOLFSWUNKEL, TIM KAMSTRA,
and TOM EISCHEN SEED & CHEMICALS,

*Petitioners,*

—v.—

PIONEER HI-BRED INTERNATIONAL, INC.,

*Respondent.*

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

## BRIEF FOR BASF CORPORATION AS AMICUS CURIAE IN SUPPORT OF RESPONDENT

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## QUESTION PRESENTED

Whether sexually reproduced plant varieties are within the statutory categories of subject matter enumerated in 35 U.S.C. § 101 (1994) for which utility patents may be granted?

## PARTIES TO THE PROCEEDING BELOW

BASF Corporation was not a party to the proceeding below. Letters from all parties consenting to the filing of this brief have been filed with the Clerk.



## TABLE OF CONTENTS

PAGE

QUESTION PRESENTED ..... i

PARTIES TO THE PROCEEDING BELOW ..... ii

TABLE OF AUTHORITIES ..... iv

ABBREVIATIONS APPEARING IN THIS BRIEF ..... viii

STATEMENT OF INTEREST OF AMICUS CURIAE .... ix

SUMMARY OF ARGUMENT ..... 1

ARGUMENT ..... 3

I. Long After The Plant-Specific Acts, Congress Enacted § 119(f), Which Clearly Reflects Its Agreement That Plants And Plant Varieties Are Within The Statutory Classes Of § 101 ..... 4

II. Utility Patent Protection For Plants And Plant Varieties Is Consistent With *FDA v. Brown & Williamson* ..... 11

CONCLUSION ..... 15

## TABLE OF AUTHORITIES

PAGE

CASES

*Blum v. Stenson*,
465 U.S. 866 (1984) ..... 14

*FDA v. Brown & Williamson Tobacco Corp.*,
529 U.S. 120 (2000) ..... 1, 11, 12

*Ex parte Hibberd*,
227 U.S.P.Q. 443 (Bd. Pat. App. & Interf. 1985) .. 3, 6

*Imazio Nursery, Inc. v. Dania Greenhouses*,
69 F.3d 1560 (Fed. Cir. 1995) ..... 12

*Red Lion Broadcasting Co. v. FCC*,
395 U.S. 367 (1969) ..... 8

*United States v. Borden Co.*,
308 U.S. 188 (1939) ..... 14

*United States v. Rutherford*,
442 U.S. 544 (1979) ..... 8

CONSTITUTION

U.S. Const. art. I, § 8, cl. 8 ..... 3



## TABLE OF AUTHORITIES (Cont'd)

PAGE

STATUTES

7 U.S.C. §§ 2321-2583 (1994) ..... 3, 4

7 U.S.C. § 2402(a)(4) (1994) ..... 5

7 U.S.C. § 2543 (1994) ..... 13

7 U.S.C. § 2544 (1994) ..... 13

21 U.S.C. § 301 *et seq.* (1994) ..... 11

35 U.S.C. §§ 1-376 (1994) ..... 3

35 U.S.C. § 101 (1994) ..... passim

35 U.S.C. § 102(e) (1994) ..... 10

35 U.S.C. § 102(g) (1994) ..... 10

35 U.S.C. § 103 (1994) ..... 10

35 U.S.C. § 119 (1994) ..... 5, 6, 9

35 U.S.C. § 119(f) (Supp. V 2000) ..... passim

35 U.S.C. §§ 161-164 (1994) ..... 3

American Inventor's Protection Act of 1999,
Pub. L. No. 106-113, §§ 4001-4808, 113 Stat.
1501 (Nov. 29, 1999) ..... 1, 3

PAGE

OTHER

H.R. 3460, 104th Cong. § 602 (1996) ..... 8

H.R. 400, 105th Cong. § 602 (1997) ..... 8

H.R. 1907, 106th Cong. § 702 (1999) ..... 8

H.R. 2654, 106th Cong. § 602 (1999) ..... 8

H.R. 3194, 106th Cong. § 4802 (1999) ..... 8

H.R. Rep. No. 91-1605 (1970) ..... 4

H.R. Rep. No. 101-960 (1990) ..... 7

H.R. Rep. No. 104-784 (1996) ..... 8, 9

H.R. Rep. No. 105-39 (1997) ..... 8

H.R. Rep. No. 106-287 (1999) ..... 8

S. 1961, 104th Cong. § 602 (1996) ..... 8

S. 507, 105th Cong. § 602 (1997) ..... 8

S. 1948, 106th Cong. § 4802 (1999) ..... 8





PAGE

S. 1798, 106th Cong. § 702 (1999) ..... 8

S. Rep. No. 105-42 (1997) ..... 8

S. Treaty Doc. No. 104-17 (1999) ..... 5

145 Cong. Rec. 13,259 (1999) ..... 10

21060 Off. Gaz. Pat. Office 4 (1985) ..... 3

## ABBREVIATIONS APPEARING IN THIS BRIEF

| | |
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| AIPA | American Inventor's Protection Act of 1999, Pub. L. No. 106-113, §§ 4001-4808, 113 Stat. 1501 (Nov. 29, 1999) |
| FDA | Food and Drug Administration |
| FDCA | Food, Drug and Cosmetic Act, 21 U.S.C. § 301 *et seq.* (1994) |
| PTO | Patent and Trademark Office |



## STATEMENT OF INTEREST OF AMICUS CURIAE[1]

*Amicus* BASF Corporation ("BASF") is a leader in the field of agricultural products, such as fungicides, herbicides, insecticides and plant growth regulators, for use on all major agronomic crops. Additionally, BASF has undertaken an extensive research and development program to improve plant traits by both traditional breeding methods and recombinant DNA technologies. BASF operates many research and manufacturing facilities throughout the United States, Canada and Mexico and manufactures a broad spectrum of products for the agricultural market. BASF is a corporation organized and existing under the laws of the state of Delaware, having its headquarters in Mount Olive, New Jersey.

Utility patent protection for plants and plant varieties is vital to BASF's agricultural businesses, and to seed producers and farmers, whose business depends upon novel and improved agricultural products, including plants. From BASF's perspective, the protection available under the Plant Variety Protection Act is inadequate to promote the development of plant inventions because that protection is limited to the single variety described. It is also inadequate because protection is only available at the very end of a long research and development effort when a variety is produced, long after many of the basic and often pioneering plant inventions have been made. Utility patent protection, on the other hand, provides broad generic protection for basic plant inventions and is available early in the research phase, long prior to the final

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[1] No person or entity other than *amicus curiae*, or its counsel, made a monetary contribution to the preparation of this brief.

incorporation of those basic inventions into a specific plant variety. These advantages of utility patent protection effectively promote the development of new plants, plant varieties and other plant-related inventions to the ultimate benefit of seed producers, farmers and all who participate in agriculture. The advantages inherent in utility patent protection are simply not attainable using the limited varietal protection available under the Plant Patent Act and Plant Variety Protection Act.



## SUMMARY OF ARGUMENT

Congress recently expressed its intent that plants and plant varieties be within the statutory categories of subject matter of 35 U.S.C. § 101 (1994) in the American Inventor's Protection Act of 1999, Pub. L. No. 106-113, §§ 4001-4808, 113 Stat. 1501 (Nov. 29, 1999), by providing that utility patents claiming plants or plant varieties are entitled to priority under 35 U.S.C. § 119(f) (Supp. V 2000) based upon foreign applications for plant breeder's rights. Since foreign applications for plant breeder's rights are solely directed to plant varieties, § 119(f) unambiguously ratifies that utility patents may be granted for plants and plant varieties. This statute was enacted long after the Plant Patent Act of 1930 and the Plant Variety Protection Act of 1970, and fourteen years after the Patent and Trademark Office announced its policy that it would grant patents on plants and plant varieties under § 101. Congress therefore specifically legislated an answer to any question that may have been previously raised by the two plant-specific acts regarding patentability of plants and plant varieties under § 101.

Petitioners' reliance on *FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120 (2000), is misplaced because there is no direct, irreconcilable conflict between the Plant Variety Protection Act and Title 35. Neither the "research exemption" nor the "crop saving exemption" of the Plant Variety Protection Act grants an affirmative right, so neither conflicts with the exclusive rights granted by a utility patent under Title 35. If the plant-specific acts were construed to exclude plants and plant varieties from protection by utility patent, they would contradict Congress' explicit intent expressed in § 119(f) that plants and plant varieties are protectable by utility patent. Congress could not have intended plants and plant varieties to be protectable by utility patent yet

at the same time intended the Plant Variety Protection Act and the Plant Patent Act to be the exclusive form of protection for plants. Given that direct conflict, the only reasonable conclusion is that Congress intended to provide protection to sexually reproduced plant varieties under both the Plant Variety Protection Act and §101.



## ARGUMENT

Congress has exercised the power delegated to it in the Constitution, U.S. Const. art. I, § 8, cl. 8, to enact legislation to promote the progress of Science and the Useful Arts in a number of ways that are applicable to plants. The resulting statutory framework created a Patent and Trademark Office ("PTO") within the Department of Commerce to administer a patent system for inventions included within the scope of broadly defined subject matter listed in 35 U.S.C. § 101 (1994). 35 U.S.C. §§ 1-376 (1994). In this statute Congress specifically provided that *asexually* reproduced plants be protectable by plant patents issued by the PTO in consultation with the Department of Agriculture. 35 U.S.C. §§ 161-164 (1994). Finally, Congress also provided for establishment of a Plant Variety Protection Office within the Department of Agriculture to administer a system for protecting *sexually* reproduced plant varieties. 7 U.S.C. §§ 2321-2583 (1994).

Sixteen years ago, the PTO concluded, upon review of these statutes, that sexually reproduced plants and plant varieties were within the categories of invention for which utility patents may be granted under § 101, despite the existence of the additional scheme for protecting sexually reproduced plant varieties administered by the Department of Agriculture. 21060 Off. Gaz. Pat. Office 4 (1985) (citing *Ex parte Hibberd*, 227 USPQ 443 (Bd. Pat. App. & Interf. 1985)). Congress deferred to this PTO policy in not passing legislation to change it. Moreover, in a recent amendment to the patent laws, the American Inventor's Protection Act of 1999, Pub. L. No. 106-113, §§ 4001-4808, 113 Stat. 1501 (Nov. 29, 1999) ("AIPA"), Congress unambiguously ratified the PTO's conclusion that sexually reproduced plants and plant varieties are protectable by utility patent in a specific legislative provision, 35 U.S.C. § 119(f), under which utility patents under

§ 101 may claim priority to a foreign application for plant breeder's rights, which is the foreign equivalent to a United States plant variety protection certificate under 7 U.S.C. §§ 2321-2583. This provision of the AIPA has meaning only if Congress intended in 1999 that plants and plant varieties were protectable by utility patents under § 101. Thus, § 119(f) specifically addresses protection for plants and plant varieties by utility patent, confirms that such protection is available and constitutes the last word of Congress on that issue.

## I. Long After The Plant-Specific Acts, Congress Enacted § 119(f), Which Clearly Reflects Its Agreement That Plants And Plant Varieties Are Within The Statutory Classes Of § 101

Upon enacting the Plant Variety Protection Act, Congress stated its belief that protection was not then available for sexually reproduced plants and plant varieties under the patent laws, noting that "[u]nder patent law, protection is *presently* limited to those varieties of plants which reproduce asexually . . . ." H.R. Rep. No. 91-1605, at 5083 (1970) (emphasis added). This does not mean that Congress considered sexually reproduced plants to be forever outside the statutory categories of § 101, but only that Congress observed that utility patent protection had not yet been granted for sexually reproduced plants. By 1970, Congress considered plants to be *sexually* reproducible "true-to-type"[2] and the result

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[2] The Plant Variety Protection Act requires that a protected variety be "stable, in the sense that the variety, when reproduced, will remain unchanged with respect to the essential and distinctive characteristics of the variety with a reasonable (continued...)



of human intervention and therefore no longer regarded them as products of nature. The Plant Variety Protection Act reflected that conclusion, which necessarily opened the way for inclusion of sexually reproduced plants within the statutory categories of § 101.

In 1999, long after enactment of the plant-specific acts, Congress amended Title 35 to grant the right for utility patent applications to claim priority to a foreign application for plant breeder's rights.[3] 35 U.S.C. § 119(f). Since such foreign breeder's rights are solely directed to plant varieties, Congress' grant of the right to claim priority to them is an explicit determination that plants and plant varieties are protectable by utility patent under § 101.

Until 1999, § 119 provided only for priority claims to foreign applications for patents and inventors' certificates. § 119(a), (d) (respectively). Section 119(a) requires that the foreign application to which priority is claimed (in this

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[2] (...continued)
degree of reliability commensurate with that of varieties of the same category in which the same breeding method is employed." 7 U.S.C. § 2402(a)(4) (1994).

[3] Foreign plant breeder's rights are intellectual property rights provided to breeders of plant varieties pursuant to the laws of a foreign country. Many countries have enacted laws consistent with the scheme for protecting plant varieties set forth in the International Convention for the Protection of New Varieties of Plants, Oct. 25, 1991, S. Treaty Doc. No. 104-17 (entered into force on Feb. 22, 1999). As of February 16, 2001, 47 countries have joined the Convention ("UPOV"), including the United States as of February 22, 1999.

instance, the foreign application for breeder's rights) describe the "same invention" as claimed in the later-filed United States application. The AIPA expanded the scope of this right to claim priority to include the right of utility patents to claim priority to foreign applications for plant breeder's rights by adding subsection (f):

> (f) Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.

35 U.S.C. § 119(f). Thus, in the context of a priority claim under § 119(f) to a foreign application for plant breeder's rights, the foreign application must describe the "same invention" claimed in the utility patent.

Congress amended § 119 to allow a utility patent application to claim priority to a foreign application for breeder's rights, which by definition discloses only a plant variety. Therefore, Congress directly expressed its conclusion that plants and plant varieties may be the subject of utility patents granted under § 101.

There is clear indication that Congress considered that a right of priority to foreign breeder's rights was necessary *because* plants and plant varieties were protectable by utility patent under § 101. In 1990, Congress acknowledged that the PTO Board of Patent Appeals and Interferences had concluded that the plant-specific acts were not the exclusive form of protection for plants and plant varieties, *Ex parte Hibberd*, 227 USPQ 443 (Bd. Pat. App. & Interf. 1985). Congress also



recognized that the Commissioner of Patents and Trademarks had announced, shortly after *Hibberd*, that the PTO would examine utility patent applications claiming plants and plant varieties:

> Rendered in 1985, *Ex Parte Hibberd*, was the next important decision [after *Diamond v. Chakrabarty*, 447 U.S. 303 (1980)] to consider the question of statutory construction of the Patent Act as it related to the patenting of a living subject matter. . . . Although the PTO examiner [in *Hibberd*] acknowledged that the invention met the criteria for patentability, the PTO took the position that the general patent law did not protect these specific plant materials because the subject matter could have been protected under one of the laws specifically relating to plants. In rejecting this contention, the Board of Patent Appeals relied on the Supreme Court analysis in *Diamond v. Chakrabarty*, concluding that congress did not intend the plant specific acts to be the exclusive forms of protection for plant life. Following this decision, the Commissioner of Patents and Trademarks announced that, in the future, the PTO would examine applications on inventions relating to plant life. 21060 Off. Gaz. Pat. Off. 4 (1985).

H.R. Rep. No. 101-960, at 20 (1990).

After this acknowledgment that plants and plant varieties had been found protectable under § 101, Congress made no attempt to amend that section to *exclude* plants or plant varieties. This congressional silence in deference to the PTO's interpretation of the scope of the statute it administers

demonstrates that the PTO's interpretation is consistent with the purpose of the act. *United States v. Rutherford*, 442 U.S. 544, 554 (1979) (Deferring to agency's interpretation of a statute it is charged with administering is "particularly appropriate where, as here, an agency's interpretation involves issues of considerable public controversy, and Congress has not acted to correct any misperception of its statutory objectives."); *Red Lion Broadcasting Co. v. FCC*, 395 U.S. 367 (1969) (Deferring to agency's construction is "especially" appropriate when "the Congress has not just kept its silence by refusing to overturn the administrative construction, but has ratified it with positive legislation.").

In fact, Congress began in 1996 to consider the amendment now reflected in § 119(f). There were nine legislative bills and four Senate or House Reports that demonstrate Congressional consideration of the same amendment now enacted as § 119(f). S. 1961, 104th Cong. § 602 (1996); H.R. 3460, 104th Cong. § 602 (1996); H.R. Rep. No. 104-784, at 82 (1996); S. 507, 105th Cong. § 602 (1997); S. Rep. No. 105-42, at 112 (1997); H.R. 400, 105th Cong. § 602 (1997); H.R. Rep. No. 105-39, at 81-82 (1997); H.R. 2654, 106th Cong. § 602 (1999); S. 1798, 106th Cong. § 702 (1999); H.R. 1907, 106th Cong. § 702 (1999); H.R. Rep. No. 106-287, at 68-69 (1999); S. 1948, 106th Cong. § 4802 (1999); H.R. 3194, 106th Cong. § 4802 (1999). Each of the noted four Reports acknowledges "utility protection for a plant variety" substantially as follows:

> Subsection (f) has been added to section 119 to provide for the right of priority in the United States on the basis of an application for a plant breeder's right first filed in a WTO member country or in a UPOV Contracting Party. Many foreign countries provide only a sui generis system of protection for plant varieties. Because section 119 presently addresses only patents and inventors' certificates, applicants from those countries are technically unable to base a priority claim on a foreign application for a plant breeder's right when seeking plant patent or *utility protection for a plant variety* in this country.

H.R. Rep. No. 104-784, at 82 (1996) (emphasis added).

Thus, on no less than four occasions Congress recognized that § 101 provided for protection of plants and plant varieties and considered adding § 119(f) to allow for a claim of foreign priority analogous to those provided in § 119(a) and (d). This congressional activity, all of which occurred after the enactment of the plant-specific acts, unambiguously reflects an affirmative acknowledgment that plants and plant varieties are protectable by utility patent under § 101.

Petitioner attempts to minimize the importance of § 119(f) by characterizing the bill enacting it as an "amendment tacked on the end of a lengthy, multi-subject revenue bill, and inserted among 'miscellaneous patent provisions.'" (Petitioners' Br. 26.) Despite Petitioners' characterization, § 119(f) reflects Congress' considered judgment that plants and plant varieties are protectable under § 101.

While the amendment is part of a larger bill, Congress recognized the importance of the amendment to § 119. When S. 1798, an earlier version of the AIPA, was introduced to the Senate, Senator Orrin Hatch, then Chairman of the Senate Committee on the Judiciary, commented on the "Miscellaneous Patent Provisions" section containing the amendment to § 119: "Finally, the bill will make a number of miscellaneous, yet

important patent reforms."[4] 145 Cong. Rec. 13,259 (1999). This addition of § 119(f) was part of a substantial amendment to the Patent Act. In fact, the AIPA contains eight subtitles[5] spanning 100 pages and makes substantive changes to numerous aspects of the patent laws. Simply because the AIPA was part of a still larger enactment relating to appropriations[6] does not mean, as Petitioners would have it, that Congress did not focus on the issues of whether plants and plant varieties were included in the statutory categories recited in § 101.

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[4] The substantive amendments in the "Miscellaneous Patent Provisions" concern provisional patent applications, international applications under the Patent Cooperation Treaty, limitations on damages for infringement of surgical and medical method claims, PTO maintenance and publication of documents in an electronic medium, prior invention (35 U.S.C. § 102(g) (1994)) in interferences and as prior art, and prior art created under 35 U.S.C. § 102(e) (1994) ( for purposes of 35 U.S.C. § 103 (1994).

[5] The subtitles are as follows: Subtitle A: "Inventors' Rights Act of 1999;" Subtitle B: "Patent and Trademark Fee Fairness Act of 1999;" Subtitle C: "First Inventor Defense Act of 1999;" Subtitle D: Patent Term Guarantee Act of 1999;" Subtitle E: "Domestic Publication of Foreign Filed Patent Applications Act of 1999;" Subtitle F: "Optional Inter Partes Reexamination Procedure Act of 1999;" and Subtitle H: "Miscellaneous Patent Provisions."

[6] The AIPA is Title IV of "The Intellectual Property and Communications Omnibus Reform Act of 1999," which is part of an Omnibus Appropriations Act.



In enacting § 119(f), Congress specifically addressed and ratified the determination of the PTO that utility patents may be granted for plants and plant varieties.

## II. Utility Patent Protection For Plants And Plant Varieties Is Consistent With *FDA v. Brown & Williamson*

In *FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120 (2000), this Court held that the Food, Drug and Cosmetic Act, 21 U.S.C. § 301 *et seq.* (1994) ("FDCA"), read in conjunction with Congress' subsequent tobacco-specific legislation, does not authorize the FDA to regulate tobacco products. Petitioners assert that the facts of *Brown & Williamson* are similar to the present facts and that § 101 read in conjunction with the plant-specific acts does not authorize the PTO to grant patents claiming plants or plant varieties.

In their analysis, however, Petitioners failed to acknowledge that, in *Brown & Williamson*, this Court was faced with a direct conflict that is lacking in the present case, and that this direct conflict was a critical factor in the outcome of the case. In *Brown & Williamson*, this Court found that the only regulatory action the FDA could take with respect to tobacco products was the banning of such products.[7] Any such ban of tobacco products, however, would be in direct conflict with later enacted law that, *inter alia*, regulated the labeling and advertisement of tobacco products, and adopted the express policy of protecting "commerce and the national economy . . .

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[7] This is because tobacco products, under the FDCA, would be considered unsafe, and the only action the FDA can take with respect to unsafe products is to remove them from the market.

to the maximum extent consistent with" consumers "being adequately informed about any adverse health effects." *Brown & Williamson,* 529 U.S. at 139 (citing 15 U.S.C. § 1331). These later enacted statutes indicated the clear intent of Congress to allow for the continued sale of tobacco products. "A ban of tobacco products by the FDA would therefore plainly contradict congressional policy." *Brown & Williamson,* 529 U.S. at 139. Consequently, this Court held that "the inescapable conclusion is that there is no room for tobacco products within the FDCA's regulatory scheme. If they cannot be used safely for any therapeutic purpose, and yet they cannot be banned, they simply do not fit." *Brown & Williamson*, 529 U.S. at 143.

In the present case, there is no such conflict. The Plant Variety Protection Act and the Plant Patent Act provide for the protection of sexually reproduced plant varieties and asexually produced plants, respectively. For the past sixteen years, utility patent protection has also been available for such plants, as well as for other types of plants not protectable under the Plant Variety Protection Act or the Plant Patent Act (*e.g.*, plants having genetically transmissible traits though not meeting the definition of "variety" in either statute).[8] Petitioners have been unable to point out one direct conflict between the Plant Variety Protection Act and § 101, such as the direct conflict encountered in *Brown & Williamson*. Petitioners provide a list of differences between the Plant Variety Protection Act and the utility patent provisions of Title 35. (Petitioners' Br. 22-24.) While Petitioners have characterized these differences as "conflicts," not one of these differences rises to the level of the

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[8] The Court of Appeals for the Federal Circuit has addressed the meaning of "variety" under both acts, *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1567 (Fed. Cir. 1995).



direct, irreconcilable conflict seen in *Brown & Williamson*. The Plant Variety Protection Act and utility patent protection for plants and plant varieties under Title 35 can harmoniously co-exist, and have co-existed for over sixteen years.

For example, Petitioners attempt to make much of the "research exemption" and the "crop saving exemption" under the Plant Variety Protection Act.[9] However, there is no direct conflict presented by these exemptions. The exemptions merely exclude certain activities from infringement under the Plant Variety Protection Act; they do not create an affirmative right to carry out these activities without regard to any other law or regulation that may independently prohibit or regulate such activities.[10] Therefore, the exclusive rights granted by a utility patent on a plant variety in no way impacts the exemptions of the Plant Variety Protection Act. Because the protection of plants under Title 35 does not create a direct conflict with the Plant Variety Protection Act or the Plant Patent Act, *Brown & Williamson* does not apply to these statutes.

If, as Petitioners suggest, plant varieties were not within § 101, there *would* be a direct conflict between § 101 and

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[9] The "research exemption," 7 U.S.C. § 2544 (1994), excludes from infringement the use of an otherwise protected first plant variety for the development of a second plant variety, and the "crop saving exemption," 7 U.S.C. § 2543 (1994), excludes from infringement the saving of seeds from an otherwise protected plant variety for subsequent planting.

[10] The exclusive right allows one to prevent another from performing certain acts. The exemption defines activity exempt from the exclusive right, but does not grant a right to practice any act.

§ 119(f), and the reasoning of *Brown & Williamson* would lead to a holding that plants are patentable subject matter under § 101. The Petitioners seek to exclude the protection of plant varieties under the utility patent provisions of Title 35 based in part on the alleged comprehensiveness of the Plant Variety Protection Act, which, Petitioners suggest, proves that Congress intended the Plant Variety Protection Act to provide for the protection of plant varieties to the exclusion of protection under § 101. (Petitioners' Br. 34-35.)

This proposed exclusion would be in direct conflict with the subsequently expressed intent of Congress, as evidenced by § 119(f), which unambiguously shows (without requiring any recourse to legislative history) that Congress intended § 101 to include the protection of plants. *Blum v. Stenson*, 465 U.S. 866, 896 (1984) ("[W]e look first to the statutory language and then to the legislative history if the statutory language is unclear."). The clear and unambiguous intent of Congress is therefore that plants and plant varieties are protectable subject matter under § 101. If plants and plant varieties were not considered patentable subject matter under § 101, the legislation specifically granting a right of a utility patent application to claim priority to a document that deals exclusively with plant varieties would be meaningless. *United States v. Borden Co.*, 308 U.S. 188, 198 (1939) ("When there are two acts upon the same subject, the rule is to give effect to both if possible . . . ."). The later enactment of the plant-specific § 119(f) is conclusive evidence that Congress intended plants and plant varieties to be within the scope of § 101. Under the reasoning in *Brown & Williamson*, Congress could not have intended that plants are patentable subject matter under § 101 and, at the same time, intended the Plant Variety Protection Act to exclusively provide for the protection of sexually reproduced plants. The inescapable conclusion is that Congress intended that both § 101 and the Plant Variety Protection Act be applicable to plant varieties.



## CONCLUSION

In the American Inventor's Protection Act of 1999 Congress expressed its legislative determination that plants and plant varieties are within the subject matter protectable by utility patent. This statute was enacted long after the Plant Patent Act and the Plant Variety Protection Act, and fourteen years after the Patent and Trademark Office's administrative determination that it was authorized to grant utility patents on plants and plant varieties. It addressed and resolved any question that may have been previously raised by the two plant-specific acts regarding patentability of plants and plant varieties under § 101. Congress ratified in § 119(f) the agency determination that sexually reproduced plant varieties are protectable under both the Plant Variety Protection Act and Title 35.

Respectfully submitted,

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